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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,998	08/01/2006	Andreas Eipper	12810-00333-US1	4347
30678 7590 03/11/2010 CONNOLLY BOVE LODGE & HUTZ LLP 1875 EYE STREET, N.W. SUITE 1100 WASHINGTON, DC 20006				
EXAMINER				
LEE, DORIS L				
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1796				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/587,998

**Applicant(s)**

EIPPER ET AL.

**Examiner**

Doris L. Lee

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 6-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

1. No new grounds of rejection are set forth below. Thus, the following action is made final.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

#### ***Claim Rejections - 35 USC § 103***

3. **Claims 1-3 and 6-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Gareiss et al (US 5,712,336)** in view of **Dvornic et al (US 2002/0161113)**.

The rejection is adequately set forth in paragraph 3 of the Office Action mailed on June 23, 2009 and is incorporated here by reference.

#### ***Double Patenting***

4. **Claims 1-3 and 6-19** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1, 9 and 10** of copending **Application No. 10/587,997** in view of **Dvornic et al (US 2002/0161113)**.

The rejection is adequately set forth in paragraph 5 of the Office Action mailed on June 23, 2009 and is incorporated here by reference.

5. **Claims 1-3 and 6-19** are directed to an invention not patentably distinct from **claims 1, 9 and 10** of commonly assigned copending **Application 10/587,997**.

The rejection is adequately set forth in paragraph 6 of the Office Action mailed on June 23, 2009 and is incorporated here by reference.

6. **Claims 1-3 and 6-19** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9, 12, 13, and 17-21** of copending Application **No. 11/576,646**.

The rejection is adequately set forth in paragraph 7 of the Office Action mailed on June 23, 2009 and is incorporated here by reference.

7. **Claims 1-3 and 6-19** are directed to an invention not patentably distinct from **claims 1, 5-9, 12, 13 and 17-21** of commonly assigned copending **Application 11/576,646**.

The rejection is adequately set forth in paragraph 8 of the Office Action mailed on June 23, 2009 and is incorporated here by reference.

8. **Claims 1-3 and 6-19** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9, 11, 12, 15, 16, and 20-21** of copending Application **No. 11/577,009**.

The rejection is adequately set forth in paragraph 9 of the Office Action mailed on June 23, 2009 and is incorporated here by reference.

9. **Claims 1-3 and 6-19** are directed to an invention not patentably distinct from **claims 1, 5-9, 11, 12, 15, 16, and 20-21** of commonly assigned **Application 11/577,009**.

The rejection is adequately set forth in paragraph 10 of the Office Action mailed on June 23, 2009 and is incorporated here by reference.

10. **Claims 1-3 and 6-19** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9, 12-13, 17-21** of copending Application **No. 11/577,590**.

The rejection is adequately set forth in paragraph 13 of the Office Action mailed on June 23, 2009 and is incorporated here by reference.

11. **Claims 1-3 and 6-19** are directed to an invention not patentably distinct from **claims 1, 5-9, 12-13 and 17-21** of commonly assigned **Application 11/577,590**.

The rejection is adequately set forth in paragraph 14 of the Office Action mailed on June 23, 2009 and is incorporated here by reference.

12. **Claims 1-3 and 6-19** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 6-11, and 13-14** of copending Application **No. 11/632,711**.

The rejection is adequately set forth in paragraph 15 of the Office Action mailed on June 23, 2009 and is incorporated here by reference.

13. **Claims 1-3 and 6-19** are directed to an invention not patentably distinct from **claims 1, 6-11 and 13-14** of commonly assigned **Application 11/632,711**.

The rejection is adequately set forth in paragraph 16 of the Office Action mailed on June 23, 2009 and is incorporated here by reference.

14. **Claims 1-3 and 6-19** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9, and 15-16** of copending Application **No. 11/659,506**.

The rejection is adequately set forth in paragraph 17 of the Office Action mailed on June 23, 2009 and is incorporated here by reference.

15. **Claims 1-3 and 6-19** are directed to an invention not patentably distinct from **claims 1, 5-9 and 15-16** of commonly assigned **Application 11/659,506**.

The rejection is adequately set forth in paragraph 18 of the Office Action mailed on June 23, 2009 and is incorporated here by reference.

16. **Claims 1-3 and 6-19** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9 and 12-13** of copending Application **No. 11/659,625**.

The rejection is adequately set forth in paragraph 19 of the Office Action mailed on June 23, 2009 and is incorporated here by reference.

17. **Claims 1-3 and 6-19** are directed to an invention not patentably distinct from **claims 1, 5-9 and 12-13** of commonly assigned application **11/659,625**.

The rejection is adequately set forth in paragraph 20 of the Office Action mailed on June 23, 2009 and is incorporated here by reference.

18. **Claims 1-3 and 6-19** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **14, 19-23 and 25** of copending Application **No. 11/813,833**.

The rejection is adequately set forth in paragraph 23 of the Office Action mailed on June 23, 2009 and is incorporated here by reference.

19. **Claims 1-3 and 6-19** are directed to an invention not patentably distinct from **claims 14, 19-23 and 25** of commonly assigned **application 11/813,833**.

The rejection is adequately set forth in paragraph 24 of the Office Action mailed on June 23, 2009 and is incorporated here by reference.

20. **Claims 1-3 and 6-19** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9, 12-13, and 16-20** of copending Application **No. 11/996,489**.

The rejection is adequately set forth in paragraph 25 of the Office Action mailed on June 23, 2009 and is incorporated here by reference.

21. **Claims 1-3 and 6-19** are directed to an invention not patentably distinct from **claims 1, 5-9, 12-13 and 16-20** of commonly assigned application **11/996,489**.

The rejection is adequately set forth in paragraph 26 of the Office Action mailed on June 23, 2009 and is incorporated here by reference.

22. **Claims 1-3 and 6-19** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 5-9 13-14, and 18-20** of copending Application **No. 11/815,238**.

The rejection is adequately set forth in paragraph 27 of the Office Action mailed on June 23, 2009 and is incorporated here by reference.

23. **Claims 1-3 and 6-19** directed to an invention not patentably distinct from **claims 1, 5-9, 13-14 and 18-20** of commonly assigned application **11/815,238**.

The rejection is adequately set forth in paragraph 28 of the Office Action mailed on June 23, 2009 and is incorporated here by reference.

#### ***Response to Arguments***

24. The double patenting rejections are again set forth in the above office action. It is noted that applicant requests that these rejections are to be held in abeyance until allowable subject matter is indicated. However, these rejections cannot be suspended without persuasive arguments to overcome the rejection. As such, the double patenting rejections are maintained and set forth above. It is noted that the double patenting rejections set forth against application 11/577,587 and 11/813,638 in paragraphs 11, 12, 21 and 22 in the Office Action mailed on June 23, 2009 are withdrawn because those applications have been abandoned.

25. Applicant's arguments filed November 23, 2009 have been fully considered but they are not persuasive for the reasons set forth below.



26. **Applicant's argument:** Gareiss only describes thermoplastic polyesters and does not describe or suggest the inclusion of a highly branched or hyper branched polyester.

**Examiner's response:** *In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).*

27. **Applicant's argument:** The Office must consider the reference (i.e. Gareiss) in its entirety and provide some apparent reason, not merely a conclusory statement that one would modify the reference in the manner alleged by the Office.

**Examiner's response:** *It is the examiner's position that Gareiss is open to modification as it indicates from 0 to 70 % by weight of other additives can be used (col. 1, lines 16-17). In this way, Gareiss is open to modification and as Dvornic provides a motivation for using the hyper branched polyester as an additive as set forth in the content of the rejection.*

28. **Applicant's argument:** Dvornic does not cure the deficiencies of the reference as it refers to the synthesis of general types of highly branched polymers. There is no indication that one would modify/substitute the thermoplastic polymer of Gareiss for a highly branched one.

**Examiner's response:** *Dvornic teaches a hyper branched polyester with the structure as presently claimed. The examiner is not modifying or substituting the thermoplastic*

*polymer of Gareiss, rather is incorporating the hyper branched polyester as an additive of Gareiss.*

### **Conclusion**

29. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doris L. Lee whose telephone number is (571)270-3872. The examiner can normally be reached on Monday - Thursday 7:30 am to 5 pm and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571)272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Doris L Lee/  
Examiner, Art Unit 1796

/Vasu Jagannathan/  
Supervisory Patent Examiner, Art Unit 1796